

Application No.09/839,779
Amendment dated August 6, 2007

9

RECEIVED
CENTRAL FAX CENTER
AUG 06 2007

Remarks

In the Office Action dated July 24, 2007, objection was made to the document filed 20 February 2007 because claims 55 and 81-92 had incorrect identifiers. The present document corrects the identifiers for claims 55 and 81-92 and restates Applicants "Remarks" from February 20, 2007.

Claims 56-58, 64-67 and 69-75 are withdrawn from further examination in view of the new rejection. Applicants request rejoinder of these claims in view of the enclose Declaration of Dr. Amin Kassis and the discussion below.

Priority was claimed by Applicants in the original Declaration by reference to the filing date and title of the provisional application. The failure to insert the serial number of the provisional application was unintentional. However, it is considered that the title and filing date are sufficient to identify the provisional application. Apparently, this omission of the serial number went unnoticed until the current office action.

Objection was made to the specification as referring to an unknown provisional application. The above amendment corrects this deficiency by adding the required serial number, which is the serial number of the provisional application, priority of which was claimed in the original Declaration by reference to the title and filing date. A Supplemental Declaration including the serial number will be filed as soon as possible.

Claim 77 is rejected under 35 U.S.C. §112, second paragraph. Claim 77 is amended above to correct the typographical error when transcribing the claims submitted in the Amendment dated April 21, 2005.

Claims 50-53, 59-63 and 68 are rejected under 35 U.S.C. §102(a) over Ho, et al. (ACS Meeting on April 1-5, 2001) in light of Pero, et al. (US 6,538,038). Ho is not a proper reference because it merely describes Applicants own invention. See Declaration of Amin I. Kassis, submitted herewith in accord with M.P.E.P. §715.01(c), which declares that co-authors Nan-hui Ho, Bassan Dahman and James Adelstein are not inventors of the subject

Application No. 09/839,779
Amendment dated August 6, 2007

10

matter of the present application. Further, Applicants herein filed a provisional application, Serial No. 60/199,350, on April 25, 2000, which shows possession of the present invention prior to the Ito publication.

Further, Pero discloses targeting endothelial phosphatases selectively induced at enhanced levels at sites of vasculature proliferation. In the present invention, Applicants are targeting tumor-cell associated phosphatases. Also, Pero's prodrug is an agent that binds to tubulin whereas Applicants' compound does not bind to anything (it just gets trapped within extracellular space within a tumor). In addition, Pero's agents are nonradioactive and are selectively toxic to malignant cell (not toxic to nonmalignant cells) whereas Applicants' agents are radioactive and they kill normal cells and tumor cells with same efficiency (their tumor toxicity is consequent to the concentration of radioactivity selectively within extracellular space of tumors).

Applicants also wish to note that the statement in the office action regarding extracellular phosphatase is misleading. Many phosphatases occur inside cells (the intracellular phosphates concentration far exceeds that outside the cells). Applicants' negatively charged prodrugs molecules are protected from intracellular phosphatases because these prodrug molecules are unable to pass the plasma cell membrane.

In view of the Declaration of Dr. Kassis and the discussion above, it is respectfully submitted that the present application is in condition for allowance. An early reconsideration and notice of allowance are earnestly solicited.

Upon allowance of the claims 50-53, 59-63 and 68, Applicant requests that all claims dependent from those claims be reinstated and allowed.

Dated: 6 Aug '07

Respectfully submitted,

By 

George W. Neuner

Registration No.: 26,964

Application No.09/839,779
Amendment dated August 6, 2007

11

EDWARDS ANGELL PALMER & DODGE
LLP
P.O. Box 55874
Boston, Massachusetts 02205
(617) 517-5538
Attorneys/Agents For Applicant

nos2_592910.1